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512

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,619 11/15/99 SEITER

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EXAMINER

QM12/0813

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ARNOLD, III, T	
ART UNIT	PAPER NUMBER

3728
DATE MAILED:

08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/423,619

Applicant(s)

Selter

Examiner

Troy Arnold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 25, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 26-30 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 26-30 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast in view of Wang. Pendergast teaches all the limitations of claim 26 except cushioned layers specifically located in the metatarsus/tarsus transition area and the metatarsus/heel transition area, each (first, second, and third) cushioned layer being divided into individual fields. In Fig 5, Wang teaches cushion areas on an insole which appear to correlate to the metatarsus/tarsus transition area and the metatarsus/heel transition area. It would have been obvious in view of Wang to incorporate cushions specifically in these areas, or to divide cushion 24 of Pendergast into front and back cushion segments (which would then correspond to these two areas), for the purpose of ensuring a more effective, therapeutic and accurately supportive insole surface. Regarding the individual fields, Pendergast does teach a cushioned layer 25-34 in the forefoot joint area which is divided into individual fields. Pendergast teaches the cushioned layers being located at support areas; it appears that the insole of Pendergast would positively affect the contraction of the musculature of the foot, which would serve to aid the venous

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outflow of blood. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the other areas, the metatarsus transition and metatarsus heel areas, of the insole of Pendergast for the purpose of providing the same benefits as are provided by the division on the forefoot area. Pendergast teaches all the limitations of claim 27; see item 20 in Fig 1.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Mauch or Sawyer. Both Mauch and Sawyer teach substantially oval-shaped cushion layers in the heel area. See Mauch, Fig 1, item 8. See Sawyer, Fig 1, item a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel cushion layer of Pendergast oval-shaped for a variety of art conventional reasons, such as comfort under the heel. (See the cited art not relied upon for a number of different variations in shape and orientation of insole cushion layers.)

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Shames. Shames teaches a sickle-shaped insole cushion layer 26 in the plantar arch area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a sickle-shaped cushion layer in the plantar arch area of Pendergast for the purpose of providing more arch support to the foot.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 29 above, and further in view of Fenton or Alianiello. Both Fenton and Alianiello teach cushioned layers recessed in a sole base body. It would have been obvious to one

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of ordinary skill in the art at the time the invention was made to recess the cushion layers of Pendergast into a sole base body, if the sole base body 18 were thicker, for the purpose of better securing the layers to the base body, or for modulating the total amount of cushioning effect provided by the layers.

Response to Remarks

Contrary to the remarks, it is maintained that Pendergast teaches cushioned layers. The “control” layer 14 comprises plural cushioned layers. See column 5, beginning in line 1.

Regarding the remainder, Applicant argues distinctions which are not in the claims.

Receipt of the Applicant’s papers is acknowledged.

Conclusion

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Troy Arnold whose telephone number is (703)305-0621. The Examiner can normally be reached Monday through Friday from 9:00 am until 5:00 pm EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

TGA

August 10, 2001


DAVID T. FIDEI
PRIMARY EXAMINER